

DETAILED ACTION***Election/Restrictions***

1. Claims 1-24 and 53 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10/16/09.
2. Applicant's election without traverse of Group II (claims 25-52 and 54-58) in the reply filed on 10/16/09 is acknowledged.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 25-52 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a §101 process must (1) be tied to a particular machine or apparatus or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876). If neither of these requirements is met by the claim, the method is not a

patent eligible process under §101 and should be rejected as being directed to nonstatutory subject matter.

There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent- eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test. The tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008). In this particular case, claims 25-52 fail prong (1) because the contract is executed utilizing *at least one of the* module, the processor or the network. A module is not a machine or apparatus and a network is not a machine or apparatus.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 25-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 25 recites the limitation "the delivery" in lines 6-7. There is insufficient antecedent basis for this limitation in the claim.

8. Claims 26-52 incorporate the deficiencies of claim 25, through dependency, and are also rejected.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 25-27, 29, 32-44, 46-52, and 54 are rejected under 35 U.S.C. 102(e) as being anticipated by Engel et al. (US 2002/0069085 A1).

(A) Referring to claim 25, Engel discloses a method for processing medical transactions comprising (abstract of Engel):

signaling data between a first party and a second party, wherein the data includes at least one of financial data, medical data or insurance data (para. 42 of Engel);

generating a medical service contract having a medical service parameter utilizing at least one of a contract matrix or a contract module configured to allow multiple groups of parties to enter into contract for the delivery of medical service to a patient, the generation responsive to at least one of the financial data, the medical data or the insurance data, at least one of the module or the matrix configured to be coupled to at least one of a processor or a network (para. 42, para. 37-40 of Engel);

signaling the contract between the first party and the second party (para. 42 of Engel); and

executing the contract utilizing at least one of the module, the processor or the network (para. 42 of Engel).

(B) Referring to claim 26, Engel discloses executing the contract between the first party and at least one of the second party or a third party (para. 42 of Engel).

(C) Referring to claim 27, Engel discloses selecting the contract from the contract matrix utilizing at least one of the processor, the module or the network, the selection responsive to at least one of the financial data, the medical data, the insurance data, the service parameter or a relationship between the parties (para. 42 of Engel).

(D) Referring to claim 29, Engel discloses wherein the medical service parameter is at least one of a patient priority level, a patient service level, a response time, a payment level, a reimbursement level, a medical condition, a medical profile or a preauthorization status (para. 46 of Engel).

(E) Referring to claim 32, Engel discloses enrolling a patient into a medical service plan utilizing at least one of the processor, the module or the network, the enrolment responsive to at least one of the financial data, the medical data, the insurance data or the service parameter utilizing at least one of the processor, the module or the network (para. 50 of Engel).

(F) Referring to claim 33, Engel discloses updating or viewing at least one of the contract or a patient record utilizing at least one of the processor, the module or the network (para. 54 of Engel).

(G) Referring to claim 34, Engel discloses determining a patient's insurance coverage or eligibility utilizing at least one of the processor, the module, the network or a database (para. 59 of Engel).

(H) Referring to claim 35, Engel discloses wherein determination is done prior to at least one of contract generation or a delivery of medical service to the patient (para. 59-60 of Engel).

(I) Referring to claim 36, Engel discloses determining at least one of a fee, a co-payment level or a global fee structure for a medical service or procedure utilizing at least one of the processor, the module or the network, the determination responsive to at least one of a patient service level, a patient response time, financial data, medical data, baseline medical revenue data or data polled from a database (para. 37 of Engel).

(J) Referring to claim 37, Engel discloses determining a reimbursement level for a medical service or procedure utilizing at least one of the processor, the module or the network, the determination responsive to at least one of the medical

service parameter, financial data, medical data, baseline medical revenue data or data polled from a database (para. 36 of Engel).

(K) Referring to claim 38, Engel discloses obtaining or signaling a procedure pre-authorization between at least two parties (para. 46 of Engel).

(L) Referring to claim 39, Engel discloses wherein the pre-authorization is signaled from an insuring party to one of a health care provider, a medical practitioner or a contracted party (para. 46 of Engel).

(M) Referring to claim 40, Engel discloses signaling a payment or a reimbursement level between at least two parties (para. 36 of Engel).

(N) Referring to claim 41, Engel discloses wherein the payment or reimbursement level is signaled from an insurance company to at least one of a health care provider, a non-health care provider or a contracted party (para. 43 of Engel).

(O) Referring to claim 42, Engel discloses wherein the first party is a company and the second party is one of a patient, an insurance company, a hospital, or a health maintenance organization (para. 42 of Engel).

(P) Referring to claim 43, Engel discloses wherein the first party is a company and the second party is one of a physician, a physician group, a surgeon or a medical practitioner (para. 8 of Engel).

(Q) Referring to claim 44, Engel discloses wherein the contract is signaled using email, encrypted email, a carrier wave, an encrypted carrier wave or an encryption algorithm (para. 53 and para. 58 of Engel).

(R) Referring to claim 46, Engel discloses signaling an approval for a medical procedure between at least two parties (para. 42 of Engel).

(S) Referring to claim 47, Engel discloses signaling reimbursement data between at least two parties (para. 36 of Engel).

(T) Referring to claim 48, Engel discloses referring a patient to a medical practitioner utilizing at least one of the processor, the module or the network, the referral responsive to at least one of a patient medical profile or a medical practitioner profile (para. 44-45 of Engel).

(U) Referring to claim 49, Engel discloses referring a medical practitioner to a patient utilizing at least one of the processor, the module or the network, the referral responsive to at least one of a patient medical profile or a medical practitioner profile (para. 44-45 of Engel).

(V) Referring to claim 50, Engel discloses signaling a contracted party when a patient has been referred to a medical practitioner or has contracted with a medical practitioner (para. 42 of Engel).

(W) Referring to claim 51, Engel discloses assigning a response priority to a patient utilizing at least one of the processor, the module or the network, the assignment responsive to at least one of the medical or financial data (para. 43 and para. 46 of Engel).

(X) Referring to claim 52, Engel discloses signaling a response to a patient inquiry utilizing the response priority (para. 46 of Engel).

(Y) Referring to claim 54, Engel discloses a method for processing medical transactions comprising (abstract of Engel):

signaling data between a first party and a second party, wherein the data includes at least one of financial or medical data (para. 42 of Engel);

selecting a medical service contract having a medical service parameter utilizing a processor, the selection responsive to at least of the financial or medical data or a patient service level (para. 37-40 and para. 42 of Engel);

signaling the contract between the first party and the second party (para. 42 of Engel); and

executing the contract utilizing the processor (para. 42 of Engel).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Engel et al. (US 2002/0069085 A1) in view of Matsuda (US 2002/0165730 A1).

(A) Referring to claim 28, Engel does not disclose negotiating a reimbursement level utilizing at least one of the module, the processor or the network, the negotiation responsive to a party having a right to a patent or a medical procedure patent.

Matsuda discloses negotiating a reimbursement level utilizing at least one of the module, the processor or the network, the negotiation responsive to a party having a right to a patent or a medical procedure patent (para. 116 of Matsuda).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the aforementioned features of Matsuda within Engel. The motivation for doing so would have been to determine a price for the use of the intellectual property (para. 116 of Matsuda).

13. Claims 30, 31, 45, and 55-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engel et al. (US 2002/0069085 A1) in view of Smith (US 2002/0072995 A1).

(A) Referring to claim 30, Engel discloses generating a contract for a medical procedure utilizing at least one of the module, the processor or the network; and executing the contract for the procedure utilizing at least one of the module, the processor or the network (para. 42 and para. 37-40 of Engel).

Engel does not disclose that the contract is for the use of a patented procedure.

Smith discloses generating and executing a contract for use of a patented procedure (para. 30-34 of Smith).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the aforementioned features of Smith within Engel. The motivation for doing so would have been to enable a patient licensing market (para. 7 of Smith).

(B) Referring to claim 31, Engel does not disclose selecting the patented medical procedure from a database of patented procedures utilizing at least one of the module, the processor or the network.

Smith discloses selecting the patented procedure from a database of patented procedures utilizing at least one of the module, the processor or the network (para. 27-30 of Smith).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the aforementioned features of Smith within Engel. The motivation for doing so would have been to provide potential licensees the option to conduct a search of available patents (para. 27 of Smith).

(C) Referring to claim 45, Engel does not disclose wherein the contract is executed using an electronic signature.

Smith discloses wherein the contract is executed using an electronic signature (para. 33 of Smith).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the aforementioned feature of Smith within Engel. The motivation for doing so would have been to simplify and shorten the process by not having to use mail or facsimile (para. 33 of Smith).

(D) Referring to claim 57, Engel discloses a method for processing medical transactions comprising (abstract of Engel):

signaling data between a first party and a second party, wherein the data includes at least one of financial or medical data (para. 42 of Engel);

generating a medical service contract for a medical procedure utilizing a processor, the generation responsive to at least one of financial or medical data (para. 37-40 and para. 42 of Engel);

signaling the contract between the first party and the second party (para. 42 of Engel); and

executing the contract utilizing the processor (para. 42 of Engel).

Engel does not disclose that the contract is for the use of a patented procedure.

Smith discloses generating and executing a contract for use of a patented procedure (para. 30-34 of Smith).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the aforementioned features of Smith within Engel. The motivation for doing so would have been to enable a patient licensing market (para. 7 of Smith).

(E) Claims 55, 56, and 58 repeat substantially the same limitations as claims 30 and 31, and are therefore rejected for the same reasons given above.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied prior art teaches a method and system for providing evaluation data from tracked, formatted administrative data of a service provider (US 6,915,266 B1); a system and method for facilitating

selection of benefits (US 2002/0049617 A1); and intellectual property rights management system (US 2002/0116395 A1).

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LENA NAJARIAN whose telephone number is (571)272-7072. The examiner can normally be reached on Monday - Friday, 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/LENA NAJARIAN/
Examiner, Art Unit 3686
3/26/10